

REMARKS

This application has been reviewed in light of the Office Action dated December 29, 2006. Claims 1-4 and newly added Claims 5-8 are presented for examination. Claims 1 and 5 are in independent form. Claims 1-4 have been amended to define more clearly what Applicants regard as their invention. Favorable reconsideration is requested.

Claims 1 and 4 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants believe that the amendments to the claims render these rejections moot.

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,689,100 (“Carrithers”) in view of U.S. Patent No. 6,163,771 (“Walker”).

Carrithers relates to a system for implementing an incentive award program for a customer (of the operator of the system), who wishes to sponsor such a program. The program permits participants to obtain as an award, products and/or services from merchants. The system comprises a plurality of debit cards, a filter processor and software, responsive to a debit transaction initiated by a merchant using an initiating card having an initiating account number, for transmitting debit transaction data to the filter processor. Each debit card is assigned to one participant and has a unique account number corresponding to an award account of the participant. In a preauthorization process for a debit transaction, the filter processor evaluates whether the debit card is valid and whether the merchant is an authorized merchant. The filter processor also evaluates whether sufficient points are available in the award account to cover the debit transaction. If the

debit card is valid, the merchant is an authorized merchant, and sufficient points are present, award account is debited and a validating data is generated.

As noted in the Office Action, Carrithers does not teach generating a secondary transaction number and associating said secondary transaction number with at least one primary account. *See* Office Action, page 4, lines 1 and 2. In fact, Applicants submit that Carrithers does not teach or suggest “generating a secondary transaction number and associating the secondary transaction number with the primary account, wherein the secondary transaction number is issued to a first party and is configured to facilitate a plurality of transactions”, as recited in Claim 1.

Applicants note the assertion in the Office Action that Walker discloses those features of Claim 1, but, for the following reasons, Applicants respectfully disagree. Walker relates to a method and device for generating a single-use, transaction-specific financial account number, thereby providing a high level of security for financial transactions, particularly credit card transactions. The method of Walker generates a single-use financial account identifier by accessing a first data element specific to an account, accessing a second data element including transaction-specific data, and combining the first data element and the second data element to produce the single-use financial account identifier. The single-use financial account identifier is a number that is used only one time, to perform a specific transaction.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143.

Nothing has been found in Walker that would teach or suggest a method for facilitating a non-currency-based transaction involving a secondary transaction number comprising, among other features, “generating a secondary transaction number and associating the secondary transaction number with the primary account, wherein the secondary transaction number is issued to a first party and is configured to facilitate a plurality of transactions [emphasis added]”, as recited in Claim 1.

Generally speaking, the secondary transaction number in Claim 1 is randomly generated and is associated with the primary account. To initiate a transaction, the cardholder presents the secondary transaction number to the merchant. It is clear from the Specification that the secondary transaction number in Claim 1 may be used to facilitate more than one transaction (as is recited in Claim 1, see above). The secondary transaction number recited in Claim 1 is not a single-use, transaction-specific number, as taught by Walker.

As noted above, one of the requirements of establishing a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants respectfully submit that such requirement has not been met and that therefore, Claim 1 is patentable over Carrithers and Walker.

Independent Claim 5 recites features similar to those discussed above with respect to Claim 1 and therefore is also believed to be patentable over Carrithers and Walker for at least the reasons discussed above.

The other claims in this application are each dependent from one or the other of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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